

Remarks

Claim Status

Claims 1-20 were originally filed in this application, but were subject to a restriction requirement. Applicants elected to pursue claims 9-20 and withdrew claims 1-8. During prosecution, claims 10, 13-15 and 17-18 were canceled and claims 21-26 were added. Presently, claims 1-9, 11, 12, 16 and 19-26 are pending, claims 1-8 have been withdrawn, claims 9, 11, 16 and 20-26 stand rejected and claims 12 and 19 have been objected to. By this amendment, claims 9, 11, 12, 16, 19, 20, 24, and 26 have been amended. Favorable reconsideration of the pending claims in view of the amendments and arguments set forth below is respectfully requested.

Claim Amendments

By this amendment, claims 9, 11, 12, 16, 19, 20, 24, and 26 have been amended to particularly point out and distinctly claim the subject matter which the Applicants regard as their invention. No new matter has been added by these amendments.

Response To Rejection Of Claims 16, 19, 20 And 24-26 As Unpatentable Under 35 U.S.C. § 112

The Examiner rejected claims 16, 19, 20 and 24-26 under 35 U.S.C. § 112, second paragraph for indefiniteness. The basis for the Examiner's rejection was that independent claim 16 was "indefinite because the claim contains both apparatus limitations and method steps." Claims 19, 20 and 24-26 were, presumably, rejected for depending from independent claim 16. By this amendment, independent claim 16 has been amended to recite apparatus limitations only. Accordingly, Applicants submit that this rejection has been overcome and respectfully requests that the Examiner allow independent claim 16 and dependent claims 19, 20 and 24-26 to issue.

**Response To Examiner's Claim
Rejections Under 35 U.S.C. § 101**

The Examiner rejected claims 16, 19, 20 and 24-26 under 35 U.S.C. § 101 on the grounds that the claimed invention is directed to non-statutory subject matter. Specifically, the Examiner stated that independent claim 16 “. . . is rejected because the claim is directed to neither a ‘process’ or a ‘machine,’ but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. § 101 which is drafted so as to set forth the statutory classes of invention in the alternative only.” Dependent claims 19, 20 and 24-26 were, presumably, rejected based on their dependency on independent claim 16. Applicants have amended independent claim 16, as set forth in the preceding section. Independent claim 16 is now limited to an apparatus and does not contain method steps. Accordingly, Applicants submit that the Examiner's rejection of independent claim 16 and dependent claims 19, 20 and 24-26 has been overcome and respectfully requests that the Examiner allow these claims to issue.

**Applicants' Response To Examiner's Rejection Of
Claims 9, 11, 16 And 20-26 As Being Anticipated
Under 35 U.S.C. § 102(b) By Collette, et al.**

Claims 9, 11, 16 and 20-26 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,469,612 issued to Collette, et al. (hereinafter “the ‘612 patent”). Applicants respectfully traverse this rejection.

A rejection under 35 U.S.C. § 102 requires that the cited reference contain each and every element of the claimed invention. MPEP § 706.02 IV (“ . . . for anticipation under 35 U.S.C. § 102, the reference must teach each and every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present”). The ‘612 patent fails to teach each and every element of independent claims 9 and 16. By extension, the ‘612 patent also fails to teach each and every element of dependent claims 11, 12, 21, 22, 23 which depend from independent claim 9 and dependent claims 19, 20 and 24-26 which depend from independent claim 16.

Independent claim 9 recites “a second tool different than said first tool, the second tool being configured and operable to produce a second component that is shaped to at least partially conform to the receptacle and that is dimensioned such that a substantial portion of the second component will be disposed within the receptacle when the second component is positioned within the receptacle. The ‘612 patent does not disclose this element. There is no disclosure in the ‘612 patent that the handle is molded in a second mold assembly. Recognizing this, the Examiner asserts, without support, that “[i]t is inherent that the handle is molded in a second mold assembly.” This assertion is incorrect. To establish inherency, the missing descriptive matter must **necessarily** be present in the thing described in the reference. “The law requires that inherency may not be established by possibilities or probabilities. The evidence must show that the inherency is necessary and inevitable.” *Interchemical Corp. v. Watson*, 145 F.Supp. 179, 182 (Dist. D.C. 1956) affirmed 271 F.2d 390 (D.C. Cir. 1958). The mere fact that a certain thing **may** result from a given set of circumstances is **not sufficient**. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (emphasis added). On the issue of inherency, the C.C.P.A. has held as follows: “[i]n the case of *In re Draeger, et al*, 150 F.2d 572, 574, 32 C.C.P.A. (patents) 1217, this court said (citing numerous cases in point): ‘inherency does not mean that a thing might be done, or that it might happen, as in the instant case, one out of twenty odd times; but it must be disclosed, if inherency is claimed, that the thing will *necessarily* happen.’”) *Giambalvo v. Detrick*, 168 F.2d 116, 120 (C.C.P.A.) 1948 (emphasis added).

With this guidance in mind, the proper inquiry is whether the teachings of the ‘612 patent necessarily require that the handle of the ‘612 patent be molded by a mold assembly that is separate and distinct from the mold assembly that molds the plastic container of the ‘612 patent. The answer is no. There is no reason that a single mold assembly cannot contain two or more cavities, one for molding the handle and the other for molding the plastic container. Because the handle is not necessarily molded by a separate apparatus, the Examiner’s conclusion that it is inherent that the handle is molded in a second mold assembly is unsupported.

For a second reason, the '612 patent fails to disclose each and every element of independent claim 9. Even assuming that the handle of the '612 patent is molded in a second mold assembly (an assumption which Applicants contest), there is no disclosure in the '612 patent that the second tool is configured and operable to produce a second component that is shaped to at least partially conform to the receptacle and that is dimensioned such that a substantial portion of the second component will be disposed within the receptacle when the second component is positioned within the receptacle. On the contrary, the '612 patent discloses a second component wherein a majority of the second component resides outside of recesses 23A and 23B in the plastic container of the '612 patent. Accordingly, the second component is not dimensioned such that a substantial portion of the second component is disposed within the receptacle when the second component is positioned within the receptacle.

For the reasons set forth above, Applicants submit that the Examiner's rejection of independent claim 9 has been overcome and respectfully requests that the Examiner withdraw this rejection and allow this claim to issue.

Dependent claims 11, 21, 22 and 23 depend from independent claim 9 and therefore incorporate each and every limitation of that independent claim. Accordingly, for at least the same reasons that independent claim 9 is not anticipated by the '612 patent, dependent claims 11, 21, 22 and 23 are also not anticipated by the '612 patent. Accordingly, Applicants submit that the Examiner's rejection of these dependent claims has been overcome and respectfully requests that the Examiner withdraw this rejection and allow these claims to issue.

Independent claim 16 recites a first tool having a mold cavity and **a mold element having a protrusion**, the mold element being moveable between a first position in which at least a majority of the mold element is positioned outside the cavity and a second position in which the mold element at least substantially obstruct the cavity, wherein the first tool forms a first trim component having a receptacle having a recess that corresponds to the protrusion when a material is introduced into the mold cavity while the mold element is in the

second position.” The ‘612 patent does not disclose this. Rather, each of the mold elements 73A and 73B lack the requisite protrusion which could form a recess in a receptacle. This is why the receptacles (23A and 23B) formed in the plastic container of the ‘612 patent lack the recess required by independent claim 16. Accordingly, the ‘612 patent fails to disclose each and every element of independent claim 16. Applicants submit that this rejection of independent claim 16 has been overcome and respectfully requests that the Examiner withdraw this rejection and allow this claim to issue.

Furthermore, independent claim 16 requires “a second tool assembly different from the first tool assembly,” as did independent claim 9. The arguments set forth in the preceding section regarding the ‘612 patent’s failure to inherently disclose a second tool assembly separate from a first tool assembly applies with equal force to independent claim 16. Accordingly, for this second independent reason, the ‘612 patent fails to disclose each and every element of independent claim 16. Applicants submit that this rejection of independent claim 16 has been overcome and respectfully requests that the Examiner withdraw this rejection and allow this claim to issue.

Dependent claims 19, 20 and 24-26 depend from independent claim 16 and, necessarily, incorporate each and every limitation of independent claim 16. Accordingly, for at least the same reasons that independent claim 16 is not anticipated by the ‘612 patent, dependent claims 19, 20 and 24-26 are also not anticipated. Accordingly, Applicants submit that the Examiner’s rejection of dependent claims 19, 20 and 24-26 has been overcome and respectfully request that the Examiner withdraw this rejection and allow these claims to issue.

Response To Examiner's Claims Objections

The Examiner has objected to claims 11, 12, 19 and 20 under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Examiner asserts that “[c]laims 11, 12, 19 and 20 merely define the structure of the article and do not further describe the structure of the molding apparatus.” Applicants have amended dependent claims 11, 12, 19 and 20 to further describe the structure of the molding apparatus. Accordingly, Applicants submit that the Examiner’s objection of claims 11, 12, 19 and 20 have been overcome and respectfully request that the Examiner withdraw these objections and allow these claims to issue.

Conclusion

Applicants have made a genuine effort to respond to the Examiner’s objections and rejections in advancing the prosecution of this case. Applicants believe that all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested.

The Petition fee of \$120.00 is being filed electronically herewith. Please charge any additional fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978.

Respectfully submitted,

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